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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,618	08/07/2001	Fumitake Yodo		1742

7590

08/04/2003

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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/923,618

Applicant(s)

YODO, FUMITAKE

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 01 March 1959.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 06/600,509.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Acknowledgments*

1. The amendment filed May 9, 2003 (Paper No. 12) is acknowledged. Accordingly, claims 11 and 12 remain pending.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 11 and 11, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Peterson, Jr. (U.S. 5,857,020) ("Peterson '020"). Peterson '020 discloses in the alternative embodiment shown in figure 3: a terminal device (86, 98 and 70 all shown in figure 3); storing accounting points in a first memory (at 91); storing distributed information (76, 80-85, 78, 79, 93, and 92) distributed from an external source (inherent) and attributes corresponding to the distributed information (initially the content is unavailable); updating the accounting points storing in the first memory of the terminal device and updating attributes (the various attributes 76, 80-85, 78, 79, 93, and 92) of the distributed information (making the encrypted information

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available) when the attributes is stored (e.g. when an ID is added to list 92 making the encrypted content available); when the distributed information is stored (when medium 70 is burned, the secured data 79 is in an unavailable state); when the accounting points (the funds) are updated correctly (decremented) based upon the distributed information (the requested access), the secured content is updated to an available state; carrying out account processing in the accounting center (16) based upon the accounting points transmitted from the terminal device (adding more funds to the secured card 88 through the online access to the authorization center, column 2, ~lines 62-66); when the accounting points are not updated correctly (when the system detects that the user doesn't have enough funds); a request is made at the terminal device to the accounting center for purchasing the accounting points (through the online access to the authorization center, column 2, ~lines 62-66); carrying out another account processing (providing a monthly bill to the consumer showing funds added and funds used).

4. Evidence to support the inherent features in Peterson '020 includes "online authorization process" as found column 3, ~ lines 2 and 3; the "commercial options" as found column 3, ~ lines 42-45; and the "automatic online process" as found column 9, ~ lines 52-54.

5. Regarding first and second memory locations, it is the Examiner's position that these are inherent in any computation device. Different memory addresses sufficient to hold all the claimed data disclose these limitations.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11 and 12 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson '020.<sup>1</sup> It is the Examiner's principle position that the claims are anticipated because of the inherent features as noted above.

However if not inherent, the Examiner takes Official Notice that commercial service providers provide customers with detailed billing statements that includes at least: the name and address of the customer; previous or carry-over balances including either or monies (e.g. dollars) overpaid or monies underpaid; credits received (e.g. discounts, settlements); services charged; taxes charged is old and well known in the art.<sup>2</sup> See e.g. an ordinary itemized credit card statement/bill, a utility statement/bill, or a telephone statement/bill.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson '020 to include these features. Such a modification would have

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

<sup>2</sup> Applicant is reminded that if he intends to traverse the Official Notice statement(s), he must do so properly. See §MPEP §2144.03.

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helped track billing errors because exact monies and services are tracked. This is extremely common and well known in the industries noted above.

8. For due process purposes, the Examiner again confirms that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Accordingly, the claims continue to be interpreted with their “broadest reasonable interpretation,” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). To support this position, the Examiner relies on, inter alia, the following: the previous (and third) Office Action mailed March 24, 2003, Paper No. 11, Paragraph No. 8; the second Office Action mailed October 31, 2002, Paper No. 6, Paragraph No. 7; and the first Office Action mailed April 24, 2002, Paper No. 4, Paragraph No. 7. The Examiner continues to rely heavily and extensively on this interpretation. The preceding discussion in this paragraph applies to all examined claims currently pending.

9. The Examiner maintains his interpretations as stated in the previous Office Actions. To the extent that the Examiner’s interpretations are either different from or in dispute with Applicant’s interpretations, the Examiner—under the broadest reasonable interpretation standard noted above and in accordance with *In re Morris*—hereby adopts the following definitions as the broadest reasonable interpretation in all his claim interpretations:

a. “**Accounting**, system that provides quantitative information about finances of a person or business activity. Includes recording, measuring, and financial information.” Dictionary of Business Terms, 3<sup>rd</sup> Edition, Barron’s Educational Series, Inc., 2000.

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b. **Server**: “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.<sup>3</sup> **Client**: “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a *server*).” *Id.* **Computer**: “Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

c. **Component** “A discrete part of a larger system or structure. *Id.*

d. **Data** “Plural of the Latin *datum*, meaning an item of information. In practice, data is often used for the singular as well as plural the form of the noun.” *Id.*

e. **Device** “A generic term for a computer subsystem.” *Id.*

f. **Electronic Commerce**: “Commercial activity that takes place by means of connected computers. Electronic commerce can occur between a user and a vendor through an online information service, the Internet, or a BBS, or between a vendor and customer computers through electronic data interchange.” *Id.*

g. **System** “Any collection of component elements that work together to perform a task.” *Id.*

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<sup>3</sup> The Examiner finds that the Microsoft Press’s *Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” used to define the term “flag.”

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h. **Information “ 2 a . . . (3): FACTS, DATA . . . ”** Merriam-Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

10. Functional recitations using the word “for” or “adapted to” (e.g. “for communicating with the accounting center” as recited in claim 11) have been given little patentable weight<sup>4</sup> because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.). Where an intended use is not desired, the Examiner recommends removing “for” and “adapted to” phrases from the claims. For example, instead of “for communicating” the Examiner suggests simply --communicating--. The preceding discussion in this paragraph applies to all examined claims currently pending.

11. It is the Examiner’s factual determination that all limitations in claims 11 and 12 have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO in making rejections.” (citations and quotations omitted)).

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<sup>4</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).



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The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

*Response to Arguments*

12. Applicant's arguments filed May 9, 2003 (in Paper No. 12) have been fully considered but they are not persuasive.

13. Applicant argues "there is no step of transmitting the account points from terminal device to the accounting center and no accounting process carried out in the accounting center based on the accounting points transmitted from the terminal device." The Examiner respectfully disagrees.

14. While the Examiner admits that these steps as argued by Applicant are not *directly* disclosed, they are *inherently* present. "A claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998).

15. Additionally, as noted above, Peterson '020 directly discloses an "online authorization process" with "commercial options" and an "automatic online process." Moreover, Peterson '020 is directed primarily to "distribution of secured prerecorded content and, in particular, to a method and apparatus for enabling access . . . ." Peterson '020, column 1, first paragraph.

16. Next, Applicant is reminded that "[t]he law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would

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require every patent document to include a technical treatise for the unskilled reader.” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001) citing *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”).<sup>5</sup> One of ordinary skill in the art need not set forth each and every detail for keeping track of a user’s account.

Applicant’s arguments suggest that the provider in Peterson ‘020 would *not* provide the consumer with his or her account balance of both monies and credits.

17. Moreover, anticipation is a question of fact, including whether or not an element is inherent in the prior art. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Again as noted earlier, it is the Examiner’s factual determination that these features are inherent because its considered old and well known in this service industry to provide detailed billing statements.

18. While the Examiner agrees that Applicant’s amendments to the claims make the obviousness rejection based upon ‘standard accounting practices’ no longer applicable, the Examiner maintains his position that such features are admitted prior art.

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<sup>5</sup> See also *In re Eltgroth*, 419 F.2d 918, 921, 164 USPQ 221, 223 (CCPA 1970) (“This court has often observed that minutiae of descriptions or procedures perfectly obvious to one of ordinary skill in the art yet unfamiliar to laymen need not be set forth.”).

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***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

20. Unless expressly noted otherwise by the Examiner, the following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8<sup>th</sup> Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

21. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed.

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Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

22. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because the references are directed towards beginners (see “User Level: Beginning . . .”), the Examiner finds that the references are primarily directed towards those of *low* skill in this art. Because the references are directed towards those of low skill in this art, the Examiner finds that one of *ordinary* skill in this art must—at the very least—be aware of the knowledge and information contained within the references.

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23. All factual findings and conclusions of law in this Office Action are based the entire record. Although the Examiner may have singled out various items of evidence (e.g. Peterson '020) and expressly noted their content, this does *not* mean that the other documents of record were not considered and applied when making the prior art rejections above. Moreover, because the cannons of claim construction are generally viewed from a person of ordinary skill in the art,<sup>6</sup> the other documents of record not specifically mentioned in the prior art rejections above were used in the Examiner's deliberative process to access, inter alia, the definiteness of the claims, the level of skill in the art, and ultimately the patentability of the claimed invention.

24. The prior art made of record considered pertinent to Applicant's disclosure includes the following: Wasilewski et. al. (U.S. 6,516,412 B2); Akins, III et. al. (U.S. 56,526,508 B2); Kim (U.S. 6,519,412 B1); and Uranaka et. al. (U.S. 6,470,085 B1).

25. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner again notes and thanks Applicant for their "Remarks" (Paper No. 12 beginning on Page 5) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal

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<sup>6</sup> See e.g. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)(noting that the definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim).

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conclusion made by the Examiner in this Office Action whether expressly stated or implied<sup>7</sup>, the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in his next properly filed response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

Handwritten signature of Andrew J. Fischer, dated 7/27/03.

Andrew J. Fischer  
Patent Examiner

Handwritten signature of Robert P. Olszewski, dated 7/28/03.

ROBERT P. OLSZEWSKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

AJF  
July 27, 2003

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<sup>7</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.